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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/877,317 06/17/97 COOK

P ISIS-2508

EXAMINER

HM12/0216

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ART UNIT

PAPER NUMBER

~ 1633

DATE MAILED:

02/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/877,317

Applicant(s)
Cook

Examiner
James Martinell

Group Art Unit
1633



☒ Responsive to communication(s) filed on Jan 4, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-16, 19, 20, and 24-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-16, 19, 20, and 24-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The Office action mailed September 27, 1999 contained an error in that that Office action should have been made Final, but was not. Accordingly, the Advisory action mailed January 20, 2000 is vacated and this Final Office action is in response to the Request for Reconsideration filed January 4, 2000.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

References AO, AP, AT, and BO listed on the form PTO-1449 filed July 2, 1999 have been considered. References AO and AT have been listed by their WO publication document numbers rather than their PCT serial numbers.

Claims 13-16, 19, 20, and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant application does not adequately teach an effect on any

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organism by administration of any of the modified PNAs mentioned in the claims. This rejection is repeated for reasons already of record (e.g., Office action mailed March 29, 1999, pages 4-5). Rojanasakul is cited here as evidence that antisense treatment of organisms involves several problems, among them, stability of the oligonucleotide, uptake of the oligonucleotide, and specificity of hybridization of modified oligonucleotides to their intended targets. The instant application does not address these problems in connection with the administration of an antisense agent to an organism. Applicant's arguments (paper no. 7) are not convincing because applicant does not address any of the potential problems outlined in the rejection. Additionally, the response filed January 4, 2000 is not convincing because applicant does not address the reasoning and evidence set forth in the rejection, but merely asserts that there is no reasoning or evidence in the rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1633.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers

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must conform with the rules published in the Official Gazette,
1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed
to J. Martinell at telephone number (703) 308-0296.


JAMES MARTINELL, Ph.D.
SENIOR LEVEL EXAMINER